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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/558,117

04/25/2000

David L Patton

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1333 7590 05/05/2004

PATENT LEGAL STAFF
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EXAMINER

KIM, CHONG R

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 05/05/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,117

Applicant(s)

PATTON ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment and Arguments

1. Applicant's amendment filed on February 23, 2004 has been entered and made of record. The Examiner notes that claims 1-9, 14-15, and 21-24 are indicated as "withdrawn" in the current amendment. However, the claims have been previously cancelled by the amendment filed on May 13, 2003. Therefore, due to the cancellation of the claims, claims 1-9, 14-15, and 21-24 are no longer pending.
2. In view of applicant's amendment, the objections to the claims have been withdrawn.
3. Applicant's arguments have been fully considered, but they are not deemed to be persuasive for at least the following reasons.

Applicants argument in response to the 112 first paragraph rejections in the previous office action is that "no new matter has been added as currently set forth by independent claim 10", since the "system of Figure 3 can be operated in a number of ways in accordance with the present invention". The Examiner responds by pointing out that the applicant's specification fails to contain a written description of the claimed invention, and of the manner and process of making and using it, in **full, clear, concise and exact terms**. More specifically, the applicant's specification fails to describe the step of "comparing the image on the document and an image of the presenter as obtained by a camera at said remote location with the stored image at said database associated with said first unique ID" as recited in lines 21-26 of claim 10. Although the Applicants argue that the system can be operated in a number of ways, the Examiner was unable

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to find an instance in the applicant's specification that describes the claimed features in full, clear, concise and exact terms.

Specification

4. The amendment filed on September 25, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the phrase "The image on the document and an image of the presenter is viewed by a camera at the remote location are compared with information obtained from the database to confirm that the individual presenting the document and associated with said first unique ID" on pages 2-3 of the amendment is considered new matter since it is not described by the specification as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

The following quotations of 37 CFR § 1.75(a) and (d)(1) are the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

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5. Claim 10 is objected to under 37 CFR § 1.75 (a) and (d)(1) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

Referring to claim 10, there appears to be a typographical error in the phrase “first and second unique ID” in line 15. It appears that the applicant intended the phrase to read “first and second unique IDs”. Appropriate correction is required.

Referring to claim 10, the phrase “information obtained by scanning of said image” in line 16 lacks antecedent basis. It appears that the applicant intended the phrase to read “information obtained by scanning of said document”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Referring to claim 10, the phrase “wherein information obtained by scanning of said image is sent to said storage location whereby said information relating to said first and second IDs are compared with information accessed from said database at said storage location for

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confirming the identity of the capture device and printing device or location that was used for producing said document” in lines 16-21 is not sufficiently described by the applicant’s specification. More specifically, the applicant’s specification is non-enabling in regards to how information relating to the first ID can confirm the identity of the capture device and printing device or location that was used for producing the document, when only the second unique ID (50) provides information in regards to the identity of the capture device and printing device or location that was used for producing the document.

7. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claim 10, the phrase “comparing the image on the document and an image of the presenter as obtained by a camera at said remote location with the stored image at said database associated with said first unique ID” in lines 21-26 is not described in the applicant’s specification. The closest instance of this feature appears to be on page 11, lines 4-9 in the applicant’s specification, where it states that “the digital image of the person is captured at the remote location 190 using a digital camera 220...the captured digital image 125 is transmitted along with the unique identification number 50 from the remote location 190 to the central location 150 where it is compared to the image stored on the server 110”. Note that only two images (the capture digital image of the person and the stored image on the server) are compared. There appears to be no indication that the image on the document and an image of

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the presenter are compared with the stored image at the database. Therefore, the applicant's specification does not describe the step of "comparing the image on the document and an image of the presenter as obtained by a camera at said remote location with the stored image at said database associated with said first unique ID", as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 10, the "wherein information obtained by scanning of said image is sent to said storage location whereby said information relating to said first and second IDs are compared with information accessed from said database at said storage location for confirming the identity of the capture device and printing device or location that was used for producing said document" in lines 16-21 renders the claim indefinite because it is unclear how "information relating to said first ID" can confirm the identity of the capture device and printing device or location that was used for producing the document, when only the second unique ID provides information in regards to the capture device and printing device or location that was used for producing the document.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rhoads, U.S. Patent No. 6,345,104, Zdybel et al., E.P. 0459792 ("Zdybel"), and Cadorette, Jr. et al., U.S. Patent No. 6,341,169 ("Cadorette").

Referring to claim 10, Rhoads discloses a method of verifying that the presenter of an authentication document is the same individual holder associated with the authentication document, comprising the steps of:

a. providing an image of said holder on the authentication document, the image including a first indicia which is not visible under normal viewing conditions, the first indicia comprising a unique ID (key data) associated with the holder of the authentication document and an image of the holder stored at a database located at a storage center (col. 3, lines 1-22 and col. 13, lines 56-65).

Rhoads does not explicitly disclose a second indicia which is invisible under normal viewing conditions, that comprises a unique ID associated with the capture device used to capture the image of the holder and the location or printer used to produce the document.

Zdybel discloses an image that includes an indicia which is invisible under normal viewing conditions (col. 9, line 57-col. 10, line 34), that comprises a unique ID associated with a

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capture device used to capture the image and the location or printer used to produce a hardcopy of the image (col. 6, lines 10-19 and col. 9, line 57-col. 10, line 34).

Rhoads and Zdybel are combinable because they are both concerned with verifying authentication documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the indicia of Zdybel in the document of Rhoads. The suggestion/motivation for doing so would have been to enhance the authentication process by providing additional information (indicia) that could be used to verify the document. The Examiner notes that the combination of Rhoads and Zdybel would provide a document with a first indicia comprising a unique ID associated with the holder as taught by Rhoads, and a second indicia comprising a unique ID associated with the capture device and the printer, as taught by Zdybel.

Rhoads further explains that the contents of the document are scanned at a first location remote from the storage location so as to obtain the unique ID information and the image (col. 3, lines 1-22 and col. 13, lines 56-65). Note that scanning the document of Rhoads and Zdybel would obtain the unique ID associated with the holder of the document (first indicia), and the unique ID associated with the capture device and printer (second indicia). Rhoads further explains that the information obtained by scanning of the image is sent to the storage location whereby the information relating to the unique IDs are compared with information accessed from the database (col. 3, lines 1-22 and col. 13, lines 56-65).

Rhoads and Zdybel do not explicitly disclose the step of confirming the identity of the capture device and printer used to produce the document. However, Zdybel's indicia includes a unique ID associated with a capture device used to capture the image and the location or printer

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used to produce a hardcopy reproduction of the image, as noted above. Therefore, since the unique IDs are compared with information accessed from the database, it would have been obvious to confirm the identity of the capture device and printer used to produce the document. The suggestion/motivation for doing so would have been to enhance the security of the document.

Rhoads and Zdybel do not explicitly disclose the step of comparing the image on the document and an image of the presenter as obtained by a camera at the remote location with the stored image at the database associated with the first unique ID.

Cadorette discloses the step of comparing an image on a document (credential) and an image of the presenter as obtained by a camera at a remote location with a stored image at a database associated with a first unique ID (col. 11, line 50-col. 13, line 20).

Rhoads, Zdybel, and Cadorette are combinable because they are all concerned with authentication systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Cadorette in the method of Rhoads and Zdybel. The suggestion/motivation for doing so would have been to enhance the reliability of the authentication process (Cadorette, col. 2, line 60-col. 3, line 2). Therefore, it would have been obvious to combine Rhoads and Zdybel with Cadorette to obtain the invention as specified in claim 10.

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Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

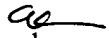
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

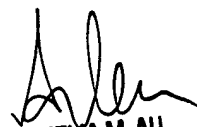
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ck

April 30, 2004


AMELIA M. AU
SUPERVISORY PATENT EXAMINER
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